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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY OR AGENT NO.
07/231,274	08/12/88	OXFORD	DK5815

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EXAMINER

FAN, J

ART UNIT  
121

PAPER NUMBER

7

DATE MAILED: 08/29/89

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on \_\_\_\_\_ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), \_\_\_\_\_ days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

**Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:**

- |   |  |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892.        | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948.                   |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.  | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____  |

**Part II SUMMARY OF ACTION**

1. ☒ Claims 1-5, 11-25 are pending in the application.  
Of the above, claims 18-20 are withdrawn from consideration.
2. ☐ Claims \_\_\_\_\_ have been cancelled.
3. ☐ Claims \_\_\_\_\_ are allowed.
4. ☒ Claims 1-5, 11-17, 21-25 are rejected.
5. ☐ Claims \_\_\_\_\_ are objected to.
6. ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on \_\_\_\_\_, has been ☐ approved. ☐ disapproved (see explanation).
12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received  
☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

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Applicant's election without traverse of group I in Paper No. 6 is acknowledged.

Claims 1, 11, 21-25 are rejected under 35 U.S.C. 112, first and second paragraphs, as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The following reasons apply:

1. The phrase "and ... salts and solvates there of" read on plural inventions and on unsupported mixtures, singular, alternative language is suggested.

2. The composition claim fails to recite an intended use.

The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at

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the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 1-5, 11-17, 21-25 are provisionally rejected under 35 U.S.C. 103 as being obvious over copending application serial number 231,260.

Copending application serial number 231,260 has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e) if patented. This provisional rejection under 35 U.S.C. 103 is based upon a presumption of future patenting of the conflicting application.

This provisional rejection might be overcome either by a showing under 37 CFR 1.132 that any unclaimed invention disclosed in the copending application was derived from the inventor of this application and is thus not the invention "by another", or by a showing of a date of invention prior to the effective U.S. filing date of the copending application under 37 CFR 1.131.

Claims 1-5, 11-17, 21-25 are provisionally rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1, 2, 4-10, 12-15 are of copending application Serial No. 231,260. Although the conflicting claims are not identical, they are not patentably distinct from each other because they encompass compounds which are homologs. Note compounds having  $n=1$  and  $n=3$  are homologs of compounds in SN 231,260.

This is a provisional obviousness type double patenting rejection because the conflicting claims have not in fact been patented.

The obviousness type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the

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patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. In re Vogel, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Any inquiry concerning this communication should be directed to Jane T. Fan at telephone number 703-557-1456.

08/25/89 nmb

*Jat Fan*  
JANE T. FAN  
PRIMARY EXAMINER  
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